

DAC

Serial No.: 09/606,495
Docket No.: 505483.003

7

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventors: Richard K. Ryan, *et al.*) Examiner: Not yet assigned
Serial No.: 09/606,495) Art Unit 2761
Filing Date: June 29, 2000)
Title: METHOD FOR MANAGING)
A FINANCIAL SECURITY)



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DEC 12 2000

OFFICE OF PETITIONS

REQUEST FOR RECONSIDERATION OF PETITION UNDER 37 C.F.R. § 1.47(a)

Office of Petitions
Box DAC
Commissioner for Patents
Washington, DC 20231

Dear Sir:

Applicant's Petition Under 37 CFR § 1.47(a) was dismissed for failure to demonstrate that two of the joint inventors, namely Messrs. Ryan and Brock, refused join in the application. For the reasons discussed below, Applicant respectfully requests reconsideration and withdrawal of the dismissal of the Petition under 37 CFR § 1.47(a).

With regard to refusal of Mr. Brock to join the Declaration signed by six (6) of his fellow co-inventors, the Petitions Examiner noted that no documentary or tangible evidence was submitted to prove that the application was presented to Mr. Brock. Applicant submits that the affidavits of Ms. Amy Jo Lee and Ms. Annette Cripps submitted with Applicant's Rule 1.47 Petition establish that Mr. Brock refused to join the application as required by 37 C.F.R. § 1.47(a). However, to alleviate the Examiner's concern, Applicant submits the affidavit of Ms. Rebecca Wempe stating that she sent an e-mail transmission to Mr. Brock and six (6) of his

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Office of Petitions, Box DAC, Commissioner for Patents, Washington, D.C. 20231 on: Date: December 6, 2000
Signature: Christina Barton

The Director is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.

co-inventors and that a true and complete copy of the application papers as filed was electronically attached to the e-mail transmission. Applicant notes that a paper copy of the e-mail transmission containing the application sent by Ms. Rebecca Wempe to Mr. Brock is attached to the affidavit of Ms. Wempe as Exhibit A.

Ms. Lee has previously stated in her affidavit filed with the original petition, that she received the e-mail transmission in question on June 23, 2000 and that it was addressed to her and six (6) other co-inventors, including Mr. Brock. This statement is confirmed by Exhibit A of Ms. Wempe's affidavit. In addition, Ms. Annette Cripps, in her previously filed affidavit, states that she presented the Declaration to Mr. Brock on June 27, 2000 and that Mr. Brock refused to sign it.

Applicant respectfully asserts that Ms. Wempe's affidavit including the attached Exhibit A clearly demonstrates that Mr. Brock was presented with an opportunity to review the application and to join the Declaration. However, as demonstrated by the previously filed affidavits by Ms. Amy Jo Lee and Ms. Annette Cripps, as well as the documentary evidence submitted herewith, the pertinent facts are that Mr. Brock refused to join in signing the Declaration. For all of the foregoing reasons, Applicant respectfully requests that the Petitions Examiner reconsider the dismissal of the Petition under § 1.47(a) with respect to Mr. Brock.

The Petitions Examiner has also stated that Applicant failed to demonstrate that joint inventor Mr. Ryan was presented with a copy of the complete application papers (specification, claims, drawings) prior to his statement of refusal. Applicant respectfully submits that the affidavit of Mr. Roger Viola, the General Counsel for Security Benefit Life Insurance Company (hereinafter "Security Benefit"), submitted with the original petition, (the "Original Viola Affidavit") provides adequate facts to establish that Mr. Ryan's conduct constituted refusal

to join the application, as required by 37 C.F.R. § 14.7(a), such that Applicant's Rule 1.47 petition is grantable.

As stated in the Original Viola Affidavit, Mr. Viola offered to send Mr. Ryan the patent application papers (¶ 5), thus presenting Mr. Ryan an opportunity to review the complete application papers. However, Mr. Ryan expressly indicated that he would not sign any application papers prepared for Security Benefit (¶¶ 4, 6). Mr. Ryan's express refusal to sign was not based on the fact that he had not reviewed the application, as suggested by the Examiner. Rather, Mr. Ryan indicated he would not sign any papers unless he received additional compensation from Security Benefit (¶ 6). Mr. Ryan's reasons for refusing to sign were confirmed by Mr. Ryan in a letter dated November 21, 2000, to Mr. Viola, discussed below. Thus, Mr. Ryan's express refusal to join the application, as expressed to Mr. Viola on June 26, 2000, clearly constitutes a refusal to join in the application under 37 C.F.R. § 1.47(a). Applicant would like to point out that 37 C.F.R. § 1.47(a) does not require that the applicant be "presented with a copy of the complete application papers (specification, claims, drawings) prior to his statement of refusal." Rather it states that to invoke the provisions of the section, the joint inventor must "refuse to join in an application for letters patent." In this case, the inventor's conduct, namely his refusal to join the application unless he was compensated, clearly constitutes a refusal to join in the application as required under 37 C.F.R. § 1.47(a). Thus, Applicant submits that its petition under 37 C.F.R. § 1.47(a) is grantable.

As indicated in the Original Viola Affidavit, the patent application needed to be filed immediately to protect Security Benefit's legitimate rights. After Applicant's Rule 1.47 Petition was filed, to confirm Mr. Ryan's refusal to join the application, to urge him to join the application, and to address the Examiner's concerns, a letter was sent via certified mail

November 6, 2000 to Mr. Ryan by Mr. Viola. As confirmed by Mr. Viola's second affidavit (the "Second Viola Affidavit"), Mr. Viola enclosed a copy of the patent application as filed for Mr. Ryan's review and files. In the letter, Mr. Viola requests that Mr. Ryan review the application, sign the Declaration and return the Declaration to him.

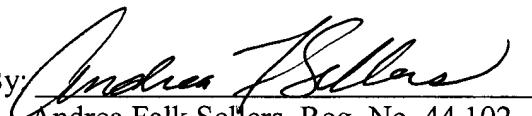
Applicant also respectfully submits a copy of a letter written by Mr. Ryan November 21, 2000, attached to the Second Viola Affidavit as Exhibit B. As demonstrated by Exhibit B, Mr. Ryan states in his letter that he received Mr. Viola's letter and that it contained a copy of the patent application. Mr. Ryan's letter also states that he "does not feel comfortable in signing the Declaration of Inventorship." Mr. Ryan's reasons for refusing to join the application are reiterated by Mr. Ryan himself in his letter to Mr. Viola. With the application in his possession, Mr. Ryan still refused to sign the application, indicating that "[I]f some agreement could be work out for some compensation, I would certainly reconsider my position."

The Second Viola Affidavit provides additional proof that a full and complete copy of the application was sent via certified mail to Mr. Ryan, Mr. Ryan was given the opportunity to review the application and that Mr. Ryan refused to sign the declaration after receiving a complete copy of the application papers.

In light of the Second Viola Affidavit, as well as the tangible evidence provided in Exhibits A and B to the Second Viola Affidavit, Applicant respectfully asserts that pertinent facts show that 1) Mr. Ryan was presented with the patent application; 2) Mr. Ryan had an opportunity to review the patent application; and 3) Mr. Ryan refused to join the Declaration with his fellow co-inventors. For all of the foregoing reasons, Applicant respectfully requests that the Petitions Examiner reconsider the dismissal of the Petition under § 1.47(a) with respect to Mr. Ryan.

In view of the foregoing evidence and remarks, it is believed that any deficiencies have been corrected and that Petition For Filing by Other Than All Inventors under 37 C.F.R. § 1.47(a) should be reconsidered and eventually granted. Such action is respectfully requested.

Respectfully submitted,

By: 
Andrea Falk Sellers, Reg. No. 44,102
Penny R. Slicer, Reg. No. 34,017
STINSON, MAG & FIZZELL, P.C.
1201 Walnut Street, Suite 2800
P.O. Box 419251
Kansas City, MO 64141-6251
Telephone: (816) 842-8600
Facsimile: (816) 691-3495
Attorney for Applicants

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Richard K. Ryan, et al.)
Serial No.: 09/606,495)
Filing Date: June 29, 2000)
Title: METHOD FOR MANAGING)
A FINANCIAL SECURITY)



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Affidavit of Rebecca Wempe

Office of Petitions
Box DAC
Attn: Latrice Bond
Commissioner for Patents
Washington, D.C. 20231

Dear Ms. Bond:

1. I am employed in the legal department for Security Benefit Group, Inc., a wholly-owned subsidiary of Security Benefit Life Insurance Company (hereinafter "Security Benefit") of Topeka, Kansas.
2. Brandt Thomas Brock (hereinafter "Brock") is a co-inventor of the patent application filed June 29, 2000 and entitled METHOD FOR MANAGING A FINANCIAL SECURITY (hereinafter the "Patent Application"), as indicated by the Declaration and Power of Attorney for a Patent Application signed by six (6) of the eight (8) co-inventors.
3. Brock was an employee of Security Benefit at the time the invention was conceived and reduced to practice and has since left the employment of Security Benefit.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to Office of Petitions, Box DAC, Commissioner for Patents, Washington, D.C. 20231 on:

Date: December 6, 2000

Signature: Christina Barton

The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.

4. On June 23, 2000, I sent an email transmission to Brock and six (6) other co-inventors. Electronically attached to the email transmission was a full and complete copy of the Patent Application as filed. A copy of the email transmission is attached as Exhibit A.

Rebecca Wempe
Rebecca Wempe

STATE OF)
)
) SS.
COUNTY OF)

On this 29th day of November, 2000, before me appeared Rebecca Wempe, who signed the foregoing instrument in my presence and made oath before me to the allegations set forth therein as being under oath.

Marilyn P. Schneider
Notary Public

 **Marilyn P. Schneider**
Notary Public
State of Kansas
My Appt. Expires 6/27/04

Slicer, Penny

From: Wempe, Rebecca [rebecca.wempe@securitybenefit.com]
Sent: Tuesday, October 24, 2000 11:20 AM
To: 'Slicer, Penny'
Subject: FW: Patent Application for Method for Managing a Financial Security.D OC



Patent Application for
Method ...

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-----Original Message-----

From: Wempe, Rebecca
Sent: Friday, June 23, 2000 10:00 AM
To: Brock, Brandt; Garvin, Greg; Goyer, Stéphane; Harwood, Brenda; Lee, Amy; Nestor, Mary; Plush, Karen
Subject: FW: Patent Application for Method for Managing a Financial Security.D OC

Attached is the patent application we intend to file on the unbundled dividend process. Stephane and I have thoroughly reviewed the application. Please call me at your earliest convenience, as I have two documents that each of you needs to sign before we can file the application: a declaration of your inventorship, and an assignment of your interest in the invention to SBL. We would like to file the application on Monday. Thank you.

-----Original Message-----

From: Slicer, Penny [mailto:slicer@stinson.com]
Sent: Thursday, June 22, 2000 12:30 PM
To: 'rebecca.wempe@securitybenefit.com'
Subject: Patent Application for Method for Managing a Financial Security.D OC

Rebecca:

Here is the final application. I sent the compare version in a seperate e-mail. Call me after you have time to review.

<<Patent Application for Method for Managing a Financial Security.DOC>>

Penny R. Slicer
Stinson, Mag & Fizzell, P.C.
1201 Walnut Street
Kansas City, MO 64106
pslicer@stinson.com
ph (816) 691-3438
fax (816) 691-3495

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Richard K. Ryan, et al.)
Serial No.: 09/606,495)
Filing Date: June 29, 2000)
Title: METHOD FOR MANAGING)
A FINANCIAL SECURITY)



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Second Affidavit of Roger Viola

Office of Petitions
Box DAC
Attn: Latrice Bond
Commissioner for Patents
Washington, D.C. 20231

Dear Ms. Bond:

1. I am General Counsel for Security Benefit Life Insurance Company (hereinafter "Security Benefit") of Topeka, Kansas.
2. Richard K. Ryan (hereinafter "Ryan") is a co-inventor of the patent application filed June 29, 2000 and entitled METHOD FOR MANAGING A FINANCIAL SECURITY (hereinafter the "Patent Application"), as indicated by the Declaration and Power of Attorney for a Patent Application signed by six (6) of the eight (8) co-inventors.
3. It is my understanding that Ryan was an employee of Security Benefit Group, Inc. at the time the invention was conceived and reduced to practice and has since left the employment of Security Benefit Group, Inc.
4. On June 26, 2000, I had a telephone conversation with Ryan, during which I stated that Security Benefit was filing a patent application to cover the METHOD FOR MANAGING A FINANCIAL that he co-invented. I asked Ryan if he would sign the application papers for the application, including his Declaration as a co-inventor. Ryan expressly stated that he would not sign the application papers for such a patent application.

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Date: December 6, 2000

Signature: Christina Barton

The Commissioner is hereby authorized to charge any additional amount required, or credit any overpayment, to Deposit Account No. 19-4409.

5. I interpreted the conduct of Ryan during my telephone conversation with him on June 26, 2000 as a clear indication that Ryan will refuse to receive, or even consider any patent application papers which I offered to send him for execution. In view of his general refusal, as set forth herein, it made no sense to waste further time by forwarding copies of the Patent Application to him before filing the Patent Application.
6. The reason given by Ryan for refusing to sign any patent application papers prepared for Security Benefit was that he wanted Security Benefit to pay him money in addition to the compensation he received as an employee of Security Benefit Group, Inc.
7. At the time of filing the application, Security Benefit was about to apply for approval from state insurance departments for the program disclosed and claimed in the Patent Application, and it was therefore necessary to immediately file the Patent Application in order to protect Security Benefit's legitimate rights in the United States and in foreign countries and to prevent irreparable damage to Security Benefit.
8. On November 6, 2000, I sent a letter to Ryan enclosing a copy of the Patent Application that he co-invented as well as the related Declaration of Inventorship. The letter was sent to Ryan's last known address via certified mail with return receipt requested. A copy of the letter is attached as Exhibit A.
9. In this letter, I informed Ryan that I had enclosed a copy of the patent application for his review and again asked Ryan if he would consider signing the Declaration.
10. I received a return letter from Ryan on November 22, 2000. A copy of Ryan's letter is attached as Exhibit B.
11. Ryan expressly stated in his letter of November 21, 2000 that he would not sign the application papers for such a patent application.

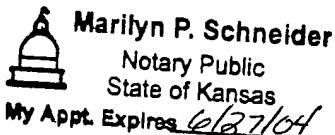


Roger Viola

STATE OF)
)
) SS.
COUNTY OF)

On this 29th day of November, 2000, before me appeared Roger Viola, who signed the foregoing instrument in my presence and made oath before me to the allegations set forth therein as being under oath.

Marilyn P. Schneider
Notary Public





Security Benefit Life Insurance Company
Security Benefit Group, Inc.
Security Distributors, Inc.
Security Management Company, LLC

700 SW Harrison St.,
Topeka, Kansas 66636-0001
(785) 431-3000

Roger K. Viola
Senior Vice President
General Counsel and Secretary
(785) 431-3137

November 6, 2000

VIA CERTIFIED MAIL
Return Receipt Requested

Mr. Richard K Ryan
260 West 113th Street
Carbondale, KS 66414

Re: Ryan, et al. U.S. Patent Application for
METHOD FOR MANAGING A FINANCIAL SECURITY

Dear Rick:

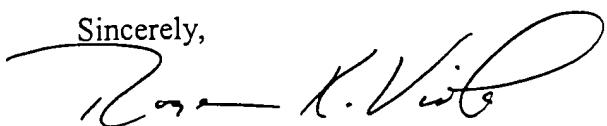
Further to our telephone conversation on June 26, 2000, this letter will confirm that we did file the above-referenced patent application with the U.S. Patent Office, indicating that you were a co-inventor of the invention, but that you refused to sign the Declaration of Inventorship. I am enclosing for your review and files a copy of the application document. I am also enclosing the Declaration of Inventorship in the hope that you will change your mind and execute the Declaration. If you will now sign the Declaration, please do so and return it to me within the next two (2) weeks. Keep in mind that signing the Declaration does not effectuate a transfer of any of your rights to Security Benefit; it simply confirms that you are, in fact, a co-inventor of the invention described in the enclosed application. If you continue to refuse to sign the Declaration, I would appreciate your letting me know within the next two (2) weeks so that I can confirm the same to the Patent Office.

While the Declaration does not convey rights in the invention to Security Benefit, I will again reiterate our position that you are obligated to assign your rights in the invention and patent by virtue of your employment with Security Benefit. You were hired to develop products, and the inventive product is a result of your product development efforts during the course of employment.

Mr. Richard K. Ryan
November 6, 2000
Page 2

I am therefore enclosing an Assignment for notarized signature. If you choose not to execute the Assignment, you should be aware that Security Benefit will take action if necessary in the future to obtain the Assignment.

Sincerely,



ROGER K. VIOLA

RKV/ms
Enclosures

REC'D NOV 22 2000

November 21, 2000

Roger K. Viola
Security Benefit Group
700 Harrison
Topeka, Ks 66636

Dear Roger,

I received your certified letter dated November 6, 2000 regarding the U.S. Patent Application for METHOD FOR MANAGING A FINANCIAL SECURITY.

Your letter makes reference to the patent application, of which a copy was enclosed, and to the Declaration of Inventorship, which you requested that I sign. Your letter did not make reference to the third enclosure titled Assignment. In reading that document, it appears that my signature would entail a complete assignment of any and all rights that I might have to this invention. I was curious as to why this enclosure was not referenced by your letter.

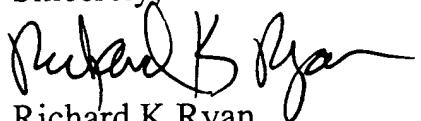
I was also surprised that Gregory J. Garvin was listed as a co-inventor. I do not recall that Greg was involved in the work to flesh out the details, pricing, administration or accounting for this newly invented method.

Finally, it is my belief that part of my compensation while employed by SBG was to participate in the profitability of the Company. While I am no longer employed by the Company, my work, which included conceiving of this idea and persistently pushing for solutions to problems of making the idea workable, entitle me to some remuneration for the future profits that will be derived from this invention.

Roger K. Viola
November 21, 2000
Page 2

For these reasons, I do not feel comfortable in signing the Declaration of Inventorship. If some agreement could be worked out for some compensation, I would certainly reconsider my position.

Sincerely,


Richard K. Ryan